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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/04/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/010,801

Applicant(s)

HAMBURG ET AL.

Examiner

Ella Colbert

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Claims 1-7, 9-25 and 27-37, 39-44 and newly added claims 45-47 are pending in this communication. Claim 1, 3-6, 9, 13, 14, 16-18, 22, 37, 39, 40, 41, and 42 have been amended and claims 8 and 38 have been cancelled in this communication filed 08/05/02 entered as Amendment E, paper no. 22.
2. The Specification objection has been overcome by Applicants' amendment to the Specification and is hereby withdrawn.
3. The objection to the Drawings has been overcome by Applicants' amendment to the Drawings and is hereby withdrawn.
4. The objection to Claims 3 and 4 have been overcome by the Applicants' amendment to Claims 3 and 4 and is hereby withdrawn.
5. The 35 USC 112, first paragraph rejection for claims 1, 8, 37, and 38 has been overcome by Applicants' canceling claims 8 and 38 and amending claims 1 and 37 and is hereby withdrawn.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7, 9-25 and 27-37 and 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol (US 6,018,342).

With respect to claim 1, Bristor teaches, maintaining in a memory a state history of a document (col. 3, lines 20-35, col. 4, lines 5-27, col. 11, lines 56-67 and col. 12, lines 1-13). Bristor did not teach, whenever an interesting operation has occurred, an interesting operation being an operation by a user that changes the state of the document, automatically capturing the state of the document as it exists after operation and adding the captured state to the state history, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have an interesting operation that has occurred, an interesting operation being an operation by a user that changes the state of the document, automatically capturing the state of the document as it exists after the operation and adding the captured state to the state history and to modify in Bristor because such a modification would allow a user in Bristor's system to create a draft ("snapshot") of the current state of the document at a particular point in time.

With respect to claim 2, Bristor teaches, the memory comprises a disk file (col. 12, lines 10-13).

With respect to claim 3, Bristor teaches, maintaining in the state history the order in which the stored states were automatically added to the state history (col. 5, lines 19-30), displaying the state history to a user as a list of document states shown in their stored order (col. 11, lines 49-60).

With respect to claim 4, Bristor teaches, the list of document states displayed to the user comprises a list of items, each item representing a state of the document that existed after an interesting operation and that can be recovered directly by selecting the item (col. 4, lines 28-49).

With respect to claim 5, Bristor teaches, providing a tool operable under user control to obtain source material from any state in the state history ("... a pointing device

and actuating the pointing device.") and apply it to a current state of the document, where the document is a raster image (col. 1, line 35-40 and lines 58-67). Bristor did not implicitly teach, the document is a raster image. However Bristor does teach, text and graphics (web page with graphics in fig. 2) based user-interfaces and history mechanisms and it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a raster image of a document and to modify in Bristor because such a modification would allow the graphics program to decide what action is to be taken with the image being displayed on the visual display representing any kind of document such as a scanned picture in a bitmapped format or any other type of document.

With respect to claim 6, Bristor did not teach, enabling a user to select an item in the displayed list of items and cause the application to create a new document having the document state corresponding to the selected item. However, Bristor does teach chronological history lists in the context of hypertext documents. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the document state correspond to the selected item and to modify in Bristor because such a modification would allow the operating system application program to create a document for each associated command that is executed in the application program linking the command together in a sequential list.

With respect to claim 7, Bristor teaches, each of the captured states in the state history maintains the state data in essentially its original form, whereby the captured state data is suitable for immediate use in other operations (col. 4, lines 56-67 and col. 5, lines 1-7).

With respect to claim 9, Bristor teaches, receiving from the user a sequence of commands to change the document (col. 6, lines 11-16 and lines 45-61), changing the

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document state in response to each command (col. 6, lines 29-51), for each document state added to the state history, adding a corresponding entry to a history list displayed to the user on a computer-controlled display device operated as part of a graphical user interface (col. 2, lines 30-44 and lines 61-67), and in response to a user action (col. 4, lines 36-42), selecting an item in the history list and establishing the document state corresponding to the selected item in the history list as the current state of the document (col. 4, lines 42-52). Bristor did not teach, adding the changed document state to a state history maintained in a computer-readable memory device each time the document state is changed, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a state history maintained in a computer readable memory device and to modify in Bristor because such a modification will allow changes to be made to a document and the changes to be stored in volatile memory and to be saved to a more permanent memory such as magnetic tape to prevent loss in the event of a software or hardware error causing the computer to freeze.

With respect to claim 10, Bristor did not teach, the state history and the history list are limited to storing a preset number of items and excess items are scrolled off the top of the list as new items are added, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have preset items and the excess items scrolled off the top of the list when new items are added and to modify in Bristor because such a modification with each action would be stored sequentially in the history list and to undo an action, the last action stored would be scrolled off the list and the application would take whatever measures are required to undo an action.

With respect to claim 11, Bristor teaches, the state history is stored in a region of memory and the oldest document states in the state history are discarded when free space in the region runs low (col. 12, lines 53-62 and col. 13, lines 30-58).

With respect to claim 12, Bristor teaches, the oldest document states are found and discarded by a memory management process (col. 14, lines 51-63). Bristor did not teach, a memory management process, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a memory management process and to modify in Bristor because such a modification in Bristor's computer system will be able to maintain a limited amount of memory for data storage and the oldest data will usually be deleted (discarded).

With respect to claim 13, Bristor teaches, in response to a user a command to change the document state corresponding to the selected item in the history list and established as the current state of the document, deleting items after the selected item in the history list and the corresponding document states from the state history (col. 4, lines 5-19 and lines 56-65).

With respect to claim 14, Bristor teaches, in response to a user to change the document state corresponding to the selected item in the history list and established as the current state of the document, maintaining the items after the selected item in the history list and adding a new item to the end of the history list and a new document state to the state history (col. 4, lines 31-52).

With respect to claim 15, Bristor did not teach, enabling a user interface gesture on the history list to create a new document from a document state from the state history. However, Bristor does teach, "... retrieval and display and thereafter gestures to identify the link to the hypertext document B ..." (col. 4, lines 36-39). It would have been obvious to a person of ordinary skill in the art at the time the invention was made

to have a user interface gesture and to modify in Bristor because such a modification would allow the user to select an icon and to perform an operation on the list to create a document.

With respect to claim 16, Bristor teaches, maintaining in a memory a state history of a document (col. 3, lines 61-66), and in response to a user action, selecting a first state from the state history and establishing the first selected state of the document as the current state of the document (col. 4, lines 7-23), in response to a user action, selecting a second state from the state history, the second state being a state created after the first state, as a source of data for an operation (col. 4, lines 45-52). Bristor did not teach, performing the operation with the data from the second state on the first state, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to go back to the previous state in the history list and to modify in Bristor in view of Bristor's teachings of a step backward command in the history list in col. 4, lines 7-10 and because such a modification would allow Bristor's system to allow a user to display and to retrieve the Web document which immediately follows the currently displayed Web document in the history list.

With respect to claim 17, Bristor teaches, keeping a history of document states of a document (col. 4, lines 32-52), the document states being created automatically whenever a user command to the application changes the state of the document and being complete in themselves (col. 4, lines 56-59) and enabling the user to step backward and forward through the revised history and thereby alter the state of the document to be any of the document states in the revised history (col. 4, lines 15-25).

Bristor did not teach, enabling the user to discard any of the history, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the user to discard any of the history and to modify in Bristor because such a



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modification in Bristor would allow the history list of a document and the commands performed to be updated frequently by a user.

With respect to claim 18, Bristor teaches, keeping a history of document states of a document, the document states being created automatically whenever a user command to the application changes the state of the document and being complete in themselves (col. 4, lines 56-59) and enabling the user to designate any one of the document states in the history (col. 4, lines 65-67 and col. 5, lines 1-7). Bristor did not explicitly teach, enabling the user to discard any of states in the history to create a revised history and enabling the user to designate any one of the document states in the revised history and thereby establish the designated state as the current state of the document, but it would have been obvious to one having ordinary skill in the art of document states at the time the invention was made to enable the user to discard any of the history and to install a designated state as the current state of the document and to modify in Bristor because such a modification would allow the history of a document to be updated and any unneeded history relating to the document to be discarded (deleted) by the user since the user knows the sequence of the commands performed.

With respect to claim 19, Bristor teaches, saving the history when the document is closed on a long-term storage medium, whereby the history may be restored when the document is later opened and across invocations of the application (col. 12, lines 3-13 and col. 13, lines 24-28).

With respect to claim 20, Bristor did not teach, the saved history resides in the document with final document data, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the history reside with the final document data and to modify in Bristor because such a modification would

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allow the previously generated data to be represented to the user and associated with the stored (saved) data.

With respect to claim 21, Bristor teaches, the saved history resides in a long-term data repository independent of the original document (col. 17, lines 44-67 and col. 18, lines 1-3).

With respect to claim 22, Bristor teaches, identifying for the user on a display device a set of states that the document has been in by operation of the application (col. 9, lines 10-31 and col. 12, lines 7-8 and lines 31-49) and enabling the user to designate any one of the identified states as a document state operand (col. 9, lines 32-47). Bristor did not teach, identifying to the user on a display device a set of states and providing the user an editing tool having the designated state as a document state operand, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to identify to the user the states on a display device and provide the user with an editing tool having the designated state as a document state operand and to modify in Bristor because such a modification will allow the user to be able to see what commands have been entered and what operations have been performed on the document and the user will be able to use the editing tool to give editing commands provided by the system such as cut, copy, paste, undo, and redo.

With respect to claim 23, Bristor did not teach, displaying the document in a user interface window, the document being a digital image, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to display the document in a user interface window and for the document to be a digital image and to modify in Bristor because such a modification would enable the user to perform operations on the displayed document image by selecting the icons (pictures) by using a mouse.

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With respect to claim 24, Bristor did not teach, displaying user-interface elements for applying filters to a digital image, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the filters to a digital image and to modify in Bristor because such a modification would allow many of the image processing functions to be built into paint and photopaint programs and to be applied as filters to the image.

With respect to claim 25, Bristor teaches, establishing the designated state as the current state of the document in response to a user command (col. 2, lines 10-29).

With respect to claim 27, Bristor did not teach, providing the user a delete tool for deleting the designated state from the set of states, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the user with a delete tool having a designated state and to modify in Bristor because such a modification would allow the user to undo a command using a mouse action after the command has been performed on a document.

With respect to claim 28, Bristor did not teach, the set of states is identified by displaying a scrollable list of elements, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to display a scrollable list of elements and to modify in Bristor because such a modification would allow each menu to contain a scrollable list of the menu items and the command to reflect its current appearance when displayed to the user.

With respect to claim 29, Bristor did not teach, the list of elements are ordered by the time the corresponding states were created, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the list of elements ordered by the time the corresponding states are created and to modify in Bristor because such a modification would allow Bristor's system to have the steps

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carried out in (1) order of creation command, (2) add a menu item, and (3) mark the menu's appearance to correspond to the menu item.

With respect to claim 30, Bristor teaches, the designation and establishment are performed in response to a single command (col. 4, lines 7-10 and lines 23-25).

With respect to claim 31, Bristor teaches, enabling the user to make a gesture on a user interface indicating a sequence of displayed state identifiers and responding to the gesture by displaying the document in the states indicated as the gesture is made (col. 3, lines 40-60).

With respect to claim 32, Bristor did not teach, enabling the user to modify the document state after the establishing step and adding the document state resulting from the modification to the set of states identified on the display device, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have an installing step and to modify in Bristor because such a modification would allow the user to create a state for each command in the system and the document to be displayed for the modification of the document.

With respect to claim 33, Bristor teaches, the set of states is displayed in order of creation of the states in the set (col. 4, lines 31-52).

With respect to claim 34, Bristor did not teach, the document is a digital image, but it would have been obvious to one having ordinary skill in the art of documents at the time the invention was made to have the document as a digital image and to modify in Bristor because such a modification would allow the image being displayed to represent any kind of a document such as a scanned picture in a bitmapped format or any other type of document that may be represented on a computer screen.

With respect to claim 35, Bristor teaches, providing a step backward and a step forward command for the user to execute to navigate the set of states (col. 4, lines 5-7

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and lines 25-27). Bristor did not teach, providing a separate undo and redo command for the user to undo and redo commands, but it would have been obvious to a one having ordinary skill in the art at the time the invention was made to provide separate undo and redo commands and to modify in Bristor because such a modification would enable the user to toggles between the two states of a document and to make a comparison of a result of the command. (col. 4, lines 15-25)

With respect to claim 36, this dependent claim is rejected for the similar rationale as given for claim 35.

With respect to claim 37, this independent claim is rejected for the similar rationale as given for claim 1.

With respect to claim 39, this independent claim is rejected for the similar rationale as given for claim 9.

With respect to claim 40, this independent claim is rejected for the similar rationale given for claim 16.

With respect to claim 41, this independent claim is rejected for the similar rationale given for claim 17.

With respect to claim 42, this independent claim is rejected for the similar rationale given for claim 18.

With respect to claim 43, this independent claim is rejected for the similar rationale given for claim 22.

With respect to claim 44, Bristor did not teach, providing the user a first undo command function that operates with reference to the first history and a second undo command function that operates with reference to the second history, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the user with a first undo command function that operates with reference to

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the first history and a second undo command function that operates with reference to the second history and in view of Bristor's teaching of a backward command and a forward command in col. 4, lines 5-7 and to modify in Bristor because such a modification would allow Bristor's content based history mechanism to enable a user to use the first undo command for the first history mechanism of the list of the most recently retrieved commands and the second history mechanism to store the second undo command in a history database with user data specifying an undo command which the user identifies as important.

With respect to claim 45, Bristor teaches, establishing as the current state of the document a state stored in the state history (col. 13, lines 24-28).

With respect to claim 46, maintaining in memory a history of all operations requested by a user, including operations global to the state of the application (col. 13, lines 30-40).

With respect to claim 47, this dependent claim is rejected for the similar rationale as for claim 46. Claim 47 has apparatus steps comprising instructions operable for causing a programmable processor to perform the apparatus steps of claim 46 that correspond to the apparatus steps of claim 47.

### ***Response to Arguments***

8. Applicants' arguments filed 02/05/02 have been fully considered but they are not persuasive.

1. Applicants' argue: Bristor does not disclose or suggest "maintaining in a memory a state history of a document for storing document states, whenever an interesting operation has occurred, automatically capturing the state of a document as it exists after the operation and adding the captured state history, where an interesting operation is "an operation by a user that changes the state of the document" has been

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considered but is not persuasive because Bristor is interpreted as teaching the "states of the document and the order in which the stored states were automatically added to the state history (the Netscape Web browser provides a mechanism by which a user can organize the virtual bookmarks of the structure in any order and ... can organize virtual bookmarks within a hierarchical structure) in col. 5, lines 15-30 and displayed to a user as a list of document states shown in their stored order ("... the user actuates history button 508A using a cursor 510 and in response a history menu is displayed") in a stored order is shown in fig. 5B (512) in col. 11, lines 51-53. Bristor teaches performing a step backward operation wherein all step backward operations place the document in a state that occurred immediately after [an operation that changed the state of the document] interesting operation ("... the Netscape Web browser provides a "back command, which is accessible to the user either through a pull down menu or through a virtual "back button) in col. 4, lines 7-10 and lines 15-19.

2. Applicants' argue: Because at least one element of the claimed invention is not taught or suggested by Bristor, no prima facie case of obviousness under 35 USC 103 has been established has been considered but is not persuasive based on a suggestion/ motivation need not be expressly stated in one or all of the references used to show obviousness. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985); *In re Sheckler*, 438 F.2d 999, 1001, 168 USPQ 716, 717 (CCPA 1971). It is assumed that every reference relies to some extent on the knowledge of persons skilled in the art to complement that which is disclosed therein. Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the

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person having ordinary skill in the art has a level of knowledge apart from the content of the references. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Also see MPEP 2144 entitled "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT."

3. Applicants' argument: Bristol does not, therefore, describe or suggest "displaying the state history to a user as a list of document states shown in their stored order has been considered but is not persuasive because in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "displaying the state history to a user as a list of document states shown in their stored order") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicants' argument: Bristol does not describe "a list of items, each item representing a state of the document that existed after an interesting operation and that can be recovered directly by selecting the item" has been considered but is not



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persuasive because in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a list of items, each item representing a state of the document that existed after an interesting operation and that can be recovered directly by selecting the item") are not recited in the rejected claim(s). The Examiner does not interpret the claim limitations as disclosing or suggesting "a list of items, each item representing a state of the document that existed after an interesting operation and that can be recovered directly by selecting the item". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

5. Applicants' argue: Bristor does not describe or suggest "a list of document states" where "each item represent[s] a state of the document" and, because there is no description of "a state history of a document," there is no description and no suggestion to "maintain the state data in essentially its original form" has been considered but is not persuasive it is interpreted that Bristor teaches a list of document states in col. 8, lines 51-67 and col. 9, lines 1-10 and fig. 1C.

6. Applicants' argue: Bristor does not describe "a user command to change the document state" of any of those documents, there is no suggestion to, "in response to a user command to change the document state ... maintain[] the items after the selected item in the history list and add[] a new item to the end of the history list and a new document state to the corresponding document states for the state history" has been considered but is not persuasive In response to applicant's argument that the

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references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a user command to change the document state" of any of those documents, there is no suggestion to, "in response to a user command to change the document state ... maintain[] the items after the selected item in the history list and add[] a new item to the end of the history list and a new document state to the corresponding document states for the state history") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. Applicants' argue: Bristor does not describe "selecting a second state" where the second state was "created after the first state" and there could be not state between the current state and the previous state and the forward command described by Bristor does not "perform[] the operation with the date from the second state on the first state" has been considered but is not persuasive in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "selecting a second state" where the second state was "created after the first state" and there could be not state between the current state and the previous state and the forward command described by Bristor does not "perform[] the operation with the date from the second state on the first state") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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8. Applicants' argue: Bristor does not describe or suggest "enabling the user to discard any of the states in the history to create a revised history" or "enabling the user to step backward and forward through the revised history and thereby alter the state of the document to be any of the document states in the revised history" has been considered but is not persuasive in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "enabling the user to discard any of the states in the history to create a revised history" or "enabling the user to step backward and forward through the revised history and thereby alter the state of the document to be any of the document states in the revised history") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. Applicants' argue: Bristor does not teach or suggest the use of user data to change the state of a document or adding a changed document state to a state history in claim 9 has been considered but is not persuasive because col. 8, lines 44-50 and figs. 1A and 1B, col. 9, lines 23-26 and lines 48-51 and figs. 3A and 3B, and col. 11, lines 8-60 and figs. 5A and 5B were not the columns and line numbers and figures cited for the claim limitations of claim 9. The limitations of claim 9 are not interpreted as suggesting or reciting the use of user data to change the state of a document. Bristor did not teach "adding a changed document state to a state history." The motivation is as follows: Bristor did not explicitly teach, adding the changed document state to a state history maintained in a computer-readable memory device each time the document

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state is changed, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a state history maintained in a computer readable memory device and to modify in Bristor because such a modification will allow changes to be made to a document and the changes to be stored in volatile memory and to be saved to a more permanent memory such as magnetic tape to prevent loss in the event of a software or hardware error causing the computer to freeze.

10. Applicants' argue: Bristor does not teach or suggest a command to change the document that comes after a step backward command to a selected item in the history list causes the history list and the corresponding document states to be deleted from the state history has been considered but is not persuasive because Bristor teaches a back command in col. 4, lines 15-16 ("... which is organized in reverse chronological order") changes the document that comes after a step backward command in col. 4, lines 17-19 to a selected item in the history list in col. 4, lines 21-23 causes the item after the selected item to be deleted from the history list ("... hypertext documents by removing (deleting) from the history list) in col. 4, lines 56-61 and the corresponding documents to be deleted from the state history ("... then hypertext documents F and B are removed (deleted) form the history list") in col. 4, lines 63-65.

The Examiner is entitled to give claim limitations in this rejection of claim 1 and others, for example under Section 103 of Title 35 of the United States Code, the Examiner carefully drew up a correspondence between the Applicants' claimed limitations and one or more referenced passages in Bristor, what is well known in the art and what is obvious to one having ordinary skill in the art. The Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the Specification (see below):

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2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

**>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION**

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Inquiries***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Non-Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



E. Colbert  
October 28, 2002



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600